

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board

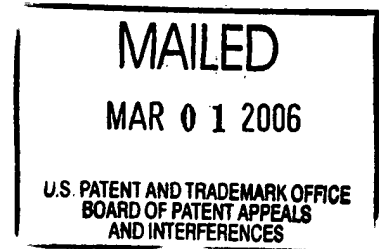
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KELLY EUGENE DILLARD,
DAVID LAWRENCE GODDARD AND
DAVID LYNN SMITH

Appeal No. 2005-1895
Application 08/861,989

ON BRIEF



Before KRASS, BLANKENSHIP, and MACDONALD, **Administrative Patent Judges**.

MACDONALD, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 25-30. Claims 1-24 have been canceled.

Invention

Appellants' invention relates to a system for transmitting a database or other software over a communication link, such as the Internet, which prevents unauthorized use. In order to prevent such unauthorized use, the customer's equipment, such as a GPS unit, is provided with a unique software key. The updated database is ordered over the communication link by providing the unique software key and may include electronic payment information. The database is encrypted, for example, as a function of the unique software key and transmitted over the communication link in encrypted form along with an upload program. The upload program only allows the encrypted database to be uploaded into a unit with a matching software key. As such, the system allows updated databases to be transmitted rather quickly and easily over a communication link while preventing unauthorized use.

Appellants' specification at page 3, lines 9-25.

Claim 25 is representative of the claimed invention and is reproduced as follows:

A method for providing navigation data to global positioning (GPS) units said method comprising the steps of:
storing a unique software key within a GPS unit;
forwarding a request from one of said GPS units for navigation data to a software supplier, said request including payment authorization information and a key code associated with the unique software key;
encrypting the navigation data by the supplier in response to said request using the included key code, said encrypted navigation data including a decryption program;
transmitting to the GPS unit having the stored unique software key, said encrypted navigation data including said decryption program which only allows software to be unloaded into a GPS unit having the unique software key;
decrypting said transmitted encrypted navigation data and decryption program at the one GPS unit according to the unique software key; and

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replacing prior navigation data at the one GPS unit with the decrypted navigation data from the supplier.

References

The references relied on by the Examiner are as follows:

Ahrens et al. (Ahrens)	5,951,620	September 14, 1999 (Filed January 26, 1996)
Behr et al. (Behr)	6,107,944	August 22, 2000 (Filed September 10, 1998)
Hornbuckle	WO 90/13865	November 15, 1990

Rejections At Issue

Claims 25-30 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Behr, Hornbuckle, and Ahrens.

Throughout our opinion, we make references to the Appellants' briefs, and to the Examiner's Answer for the respective details thereof.¹

¹ Appellants filed an appeal brief on August 13, 2004. Appellants filed a reply brief on January 6, 2005. The Examiner mailed an Examiner's Answer on November 3, 2004.

OPINION

With full consideration being given to the subject matter on appeal, the Examiner's rejections and the arguments of the Appellants and the Examiner, for the reasons stated *infra*, we reverse the Examiner's rejection of claims 25-30 under 35 U.S.C. § 103.

Only those arguments actually made by Appellants have been considered in this decision. Arguments that Appellants could have made but chose not to make in the brief have not been considered. We deem such arguments to be waived by Appellants [see 37 CFR § 41.37(c)(1)(vii) effective September 13, 2004 replacing 37 CFR § 1.192(a)].

Appellants have indicated that for purposes of this appeal the claims stand or fall together. See page 4 of the brief. We will, thereby, consider Appellants' claims as standing or falling together, and we will treat claim 25 as a representative claim of all the claims on appeal.

Whether the Rejection of Claims 25-30 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the invention as set forth in claims 25-30. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a **prima facie** case of obviousness. **In re Oetiker**, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). **See also In re Piasecki**, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in

the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. **In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellants. **Oetiker**, 977 F.2d at 1445, 24 USPQ2d at 1444. **See also Piasecki**, 745 F.2d at 1472, 223 USPQ at 788.

An obviousness analysis commences with a review and consideration of all the pertinent evidence and arguments. “In reviewing the [E]xaminer’s decision on appeal, the Board must necessarily weigh all of the evidence and argument.” **Oetiker**, 977 F.2d at 1445, 24 USPQ2d at 1444. “[T]he Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency’s conclusion.” **In re Lee**, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

With respect to independent claim 25, Appellants argue at pages 6-7 of the brief, that contrary to the Examiner’s position, because Behr transmits such limited information (information about a single route) there is no motivation to combine Behr with Hornbuckle. The Examiner counters this at page 8 of the answer stating, “[b]eyond the motivation to secure the purchased data for use only by the authorized/paying user, the GPS user may desire privacy for his selected route details/updates.” We find Appellants’ argument unpersuasive. As was pointed out by the Examiner in the rejection, Behr also teaches updating programs at column 22, lines 9-12. Clearly, the transmitted data of Behr is not as limited as argued by Appellants.

Appellants also argue at page 8 of the brief that Behr does not teach “payment authorization information.” We find this argument unpersuasive for at least the reasons set forth by the Examiner in the answer at page 7-8. Additionally we note that as used in claim 25, the “payment authorization information” is merely nonfunctional descriptive material without any functional relationship to the rest of the claim. Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. **In re Ngai**, 367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004). Cf. **In re Gulack**, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability).

Appellants also argue at page 7 of the brief that the references fail to teach “a unique software key within a GPS unit.” We find Appellants’ argument unpersuasive. Appellants have overlooked two facts in Hornbuckle. Hornbuckle teaches at page 8, lines 1-2, that RCM 18 is associated with the target computer 14. Therefore, the host computer 12 would see the RCM 18 and computer 14 as a single remote system. Further, Hornbuckle teaches at page 20, the last line, that there is a unique special key built into the RCM 18. That unique special key is used by the RCM 18 to decrypt the transmitted encryption key, which is used in turn to decrypt the rental software.

Finally, Appellants traverse the Examiner’s assertion that it would have been obvious to have alternatively provided the host with a copy of the client key as part of the initial request. The Examiner responds that evidence has been supplied supporting the official notice taken in the rejection that “the needed key can be provided by either party.” Also, the Examiner states in the

rejection that it “is a matter of system design choice to choose who transmits a copy of the key, so long as both parties use the same key.” Based on the rejection before us, we find Appellants argument on this point persuasive.

We note that the evidence supplied by the Examiner is not discussed in the Examiner’s answer, nor is it part of the rejection on appeal. Therefore, such evidence does not serve as a basis for our decision. As the basis for our decision on this point we turn to the rejection at page 5 of the answer. The Examiner does not address the fact that Hornbuckle uses a complex encryption scheme with two levels of encryption keys. Rather, the Examiner characterizes Hornbuckle as a simple “single-key encryption.” Thus, we find that the rejection does not in fact address why it would be obvious to modify the actual encryption scheme of Hornbuckle to get the encryption scheme of claim 25. Therefore, on this point the Examiner has not met the initial burden of establishing a **prima facie** case of obviousness and we will not sustain the Examiner’s rejection under 35 U.S.C. § 103.

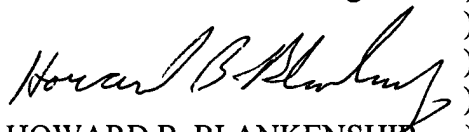
Conclusion

In view of the foregoing discussion, we have not sustained the rejection under 35 U.S.C. § 103 of claims 25-30.

REVERSED


ERROL A. KRASS)

Administrative Patent Judge)


HOWARD B. BLANKENSHIP)

Administrative Patent Judge) BOARD OF PATENT)
APPEALS AND)

INTERFERENCES)


ALLEN R. MACDONALD)

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